

Appl. No. 10/767,599
Amdt. dated 10/05/2006
Reply to Office action Mailed: 08/14/2006

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REMARKS/ARGUMENTS

The examiner identifies Dalton et al. reference 10/481,374 that was filed June 1, 2004 and publication on Oct 14, 2004 as US 2004/0201992. The pending application has a priority date to provisional application serial number 60/469,110 that was filed on May 12, 2003 therefore predating the Dalton et al. 10/481,374 reference.

The examiner identifies Watson reference US6,604,840 that was first published as US 2003/0099105 on May 29, 2003. The pending application has a priority date to provisional application serial number 60/469,110 that was filed on May 12, 2003 therefore predating the Watson publication date reference.

The applicant notes that the examiner has not address claims 23 – 26 that were presented but have not been examined in the prior two office actions and requests clarification why the examiner has failed to make a reply in regard to these claims.

Obviousness (35 USC § 103)

The examiner has rejected claims 1-9 and 11-22 under 35 U.S.C. 103(a) as being unpatentable over Watson, U.S. Patent 6,604,840 in view of Yu, U.S. Patent 6,526,680 and Dalton et al. US 20040201992A1. The applicant disagrees for the following reasons:

- 1) Watson discloses a plurality of LED light sources, while claim 1 discloses at least one (emphasis added).

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- 2) Watson is for use with a street sign, while claim 1 discloses the use with artwork or a picture (emphasis added). There is a significant difference in illumination of a street sign. Both sides of the sign are illuminated in Watson while the pending application only illuminates one side of the artwork. The illumination of the sign is for the identification of streets. The illumination of a picture or artwork is for enjoyment and appreciation.
- 3) The Dalton reference is related to an outside walkway illumination device and the applicant contends that it would not be obvious to combine illumination of a walkway with illumination of a picture or image. The applicant further contends that the examiner has not shown motivation in a reference to combine the Dalton illumination with the street sign of Watson or the license plate of Yu.
- 4) The examiner cites that the frame as used in Yu is to evenly illuminate the entire perimeter of the sign. In claim 1 only a single light source is disclosed and there is no requirement for even illumination, just supplemental illumination.

Moreover, even patentable claims are made up of known elements. "That all elements of an invention may have been old is not unusual, and indeed, irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements." *American Medical Systems Inc. v. Medical Engineering Corp.*, 6 F.3d 1523, 28 USPQ2d 1321 (Fed. Cir. 1993).

The prior art must suggest the desirability to combine. "[T]he questions is not simply whether the prior art 'teaches' the particular element of the invention,

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but whether it would 'suggest the desirability', and thus the obviousness, of making the combination." *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1498, 1 USPQ2d 1337, 1343 (Fed. Cir. 1986). In short, there is no suggestion that would lead one to combine the three references and limitations as identified by the examiner.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

(emphasis added)

While all three of the cited references involve illumination on, around or of a flat surface, there is no teaching, suggestion or motivation in the identified prior art to combine the two or more of the patents as required under 103(a). The problem being solved by the Watson is to illuminate a street sign. The problem being solved by Yu is to illuminate a license plate. The problem being solved by Dalton is to illuminate the ground. They each provide solutions to their problems, but there is no motivation

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explicitly or implicitly to combine these reference as taught within these references that is sufficient to

Words does not equate to a finding of obviousness. "[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the inventions as a whole for which patentability is claimed." *Hartness International, Inc. v. Simplicatic Engineering Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1832 (Fed. Cir. 1987).

The examiner has not shown where the reasonable expectation of success is found in the prior art, and the applicant request clarification where in the prior art the motivation and the reasonable expectation is found in the three references.

The applicant again states that in the last two office actions the examiner failed to address added claims 23-26, and the applicant requests clarification regarding the patentability of these claims. The "Disposition of the Claims" show that claims 23-26 are pending and that they are rejected, but the office action does not cite any references to reject these claims.

Independent claims 1, 8 and 15 are not obvious based upon the arguments made by the applicant. Claims 2-4, 6, 7, 11-14, 16, 18-20, 22-26 are not obvious based upon the arguments made regarding independent claims 1, 8, 15 and by virtue of their dependence on independent claims 1 8, and 15.

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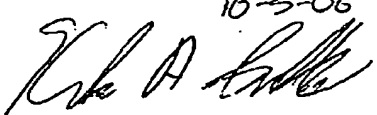
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Applicant respectfully requests that a timely Notice of Allowance be issued in
this case.

Respectfully submitted,

BUHLER & ASSOCIATES

10-5-06

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